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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,412	10/09/2001	Paul T. Brescia	7000-091	5711

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EXAMINER

BENGZON, GREG C

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/973,412

Applicant(s)

BRESCIA, PAUL T.

Examiner

Greg Bengzon

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 39-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This application has been examined. Claims 1-38 have been cancelled. Claims 39-54 have been submitted as new claims. Claims 39-54 are pending.

#### ***Priority***

The effective date of the subject matter defined in the pending claims of this application is October 9, 2001.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 39, 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 39 and 47 recite limitations '.....wherein said unique content is location specific', and '.....geographic locations based on the location specific unique content'.

With respect to Claims 39 and 47, the Examiner suggests that in reading the entirety of said Claims, a person of ordinary skill in the art would not be able to ascertain what makes said content 'unique' and 'location specific'. The Examiner notes that the same content could reside in different host devices in the same geographic location, or

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multiple copies of the same content could reside in the same storage device, and at least parts of said online content may be pulled in from other remote locations. The Examiner also suggests that the wording of the Claims may cause uncertainty regarding whether 'location specific unique content' is referring to the location of the mobile user or location of the host device.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39-43, 46-51, and 54 rejected under 35 U.S.C. 103(a) as being unpatentable over Owensby (US Patent 6647257) in view of Heddaya et al. (US Patent 6622157) hereinafter referred to as Heddaya.

With respect to Claims 39, Owensby discloses (New) a method for providing content to a mobile terminal user based on a location of a mobile terminal, comprising:

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(Abstract, Figures 1-4, Column 8 Lines 40-60, Column 19 Lines 20-50, Column 6 Lines 1-25) establishing a plurality of unique internet protocol addresses from each of which unique content may be accessed; associating each of the plurality of unique internet protocol addresses with different geographic locations (Column 11 Lines 60-65, Column 22 Lines 35-65, Column 23 Lines 1-25) ; determining a current location of the mobile terminal; determining if content is available for the current location of the mobile terminal; identifying which of the plurality of unique internet protocol addresses corresponds to the current location of the mobile terminal; (Column 22 Lines 45-55) delivering the identified address to the mobile terminal such that the mobile terminal user may selectively access the content using the identified address. The Examiner notes that while Owensby does not explicitly state providing internet protocol addresses it is obvious that in providing service provider contact information to the user, a form of internet addressing would be required in order to connect the user to the global computer network (the Internet service).

With respect to Claims 40, Owensby discloses (New) the method of claim 39 wherein the identified address is delivered to the mobile terminal via one of the group consisting of: email, short message service, system signaling seven message, and web page. (Abstract)

With respect to Claims 41, Owensby discloses the method of claim 39 further comprising allowing access to the content when the mobile terminal uses the identified address. (Column 8 Lines 40-60, Column 6 Lines 1-25)

With respect to Claims 42, Owensby discloses the method of claim 39 further comprising delivering the content to the mobile terminal in response to a request from the mobile terminal using the identified address. (Column 8 Lines 40-60, Column 6 Lines 1-25)

With respect to Claims 43, Owensby discloses the method of claim 39 further comprising receiving a trigger initiated by an action of the mobile terminal as a condition of determining the current location of the mobile terminal. (Column 8 Lines 40-60, Column 6 Lines 1-25)

With respect to Claims 46, Owensby discloses the method of claim 39 further comprising providing a profile of a user of the mobile terminal, and screening the content associated with the plurality of unique internet protocol addresses based on the profile. (Column 1 Lines 10-35, Column 18, Lines 10-30, Column 11 Lines 60-65, Column 22 Lines 35-65, Column 23 Lines 1-25)

With respect to Claims 47-51, and 54 the Applicant discloses an apparatus for the method described in Claims 39-43, 46. Claims 47-51, and 54 are rejected on the same basis as Claims 39-43, 46.

However, Owensby does not disclose a method for providing content to a mobile user wherein said unique content is location specific; and where the internet protocol address is based on the location specific unique content.

Heddaya discloses of news organizations having an overseas site that 'mirrors' the domestic site, such that the content servers at both sites contain the same material and are kept synchronized. Heddaya offloads request processing from a 'bottleneck' server to another server, thereby reducing response time.

Furthermore, Heddaya discloses another approach for offloading servicing work from home server to an intermediate node interconnected between the home server and the client. Here, the home server sends a document and code to the intermediate node. At the intermediate node, the code executes and modifies the document. The modified document is then sent to the client in a more customized form. Heddaya discloses that preferably the secondary server nodes are closer to the client nodes. (Column 3 Lines 25-40) The Examiner notes that it would be obvious that each server node would have a unique internet protocol address, said address associated with storage devices containing said customized contents.

Owensby and Heddaya are analogous art because they present concepts and practices regarding fulfilling content requests depending on the location of the mobile user. It is respectfully suggested that at the time of the invention it would have been obvious to a person of ordinary skill in the art to implement the offloaded customization concepts as taught by Heddaya into the method and apparatus of Owensby, such that content may be customized and be made unique according to the location of the intermediate node. The suggested motivation for doing so would have been, as Heddaya suggests, to distribute the servicing of requests across multiple intermediate or secondary servers, such server being closer to the requesting user (by number of hops and distance), such that response time is faster and less network traffic is created. (See Heddaya, Column s 4 Lines 1-10)

Therefore it would have been obvious to combine Heddaya with Owensby for the benefit of streamlined content delivery based on location in order to arrive at the invention as described in Claims 39-43, 46-51, and 54.

Claims 44-45 and 52-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owensby (US Patent 6647257) in view of Heddaya et al. (US Patent 6622157) hereinafter referred to as Heddaya, further in view of Guedalia (US Patent 6480711).



With respect to Claims 44-45 and 52-53, the combined teachings of Owensby and Heddaya, when applied together, substantially disclose the invention as described above.

However, the combined teachings of Owensby and Heddaya do not disclose method of claim 39 further comprising receiving a trigger unrelated to an action of the mobile terminal as a condition of determining the location of the mobile terminal. Furthermore, the combined teachings of Owensby and Heddaya do not disclose the method of claim 44 further comprising a service to generate the trigger.

Guedalia discloses a method and system whereby a mobile user has pre-programmed message requests for specific data to be transmitted according to specified schedule, such messages being triggered by activation unit and event engine, not according to a request by the mobile user. (Column 7 Lines 55-65, Column 8 Lines 1-15)

Owensby, Heddaya and Guedalia are because they present concepts and practices regarding content delivery to a mobile user. It is respectfully suggested that at the time of the invention it would have been obvious to a person of ordinary skill in the art to implement the concept of listening for signals from an activation unit and event generator as taught by Guedalia into the method and apparatus described by the combined teachings of Owensby and Heddaya, such that the system is able to receive a trigger unrelated to an action of the mobile terminal as a condition of determining the location of the mobile terminal and send messages to the user upon receiving the triggers, without any input from the mobile user. The signals from the activation unit

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and event engine may be internal to the system, or externally created by another service. The suggested motivation for doing so would have been to enable interested sponsors and even the mobile user to select and send targeted messages at the most appropriate time. For example, a flower shop may select to send content to selected mobile users within days prior to Mother's Day.

Therefore it would have been obvious to combine the concepts and practices taught by Guedalia into the combined teachings of Owensby and Heddaya for the benefit of superior marketing and advertising in order to arrive at the invention as described in Claims 44-45 and 52-53.

### ***Response to Arguments***

Applicant's arguments filed February 11, 2005 have been fully considered but they are not persuasive. The reasons for non-persuasiveness are set forth below.

The Applicant suggests that the Patent Office has not established obviousness because the Patent Office has not shown each and every element in the Claims.

The Applicant explains that by providing the mobile terminal with the specific address corresponding to the specific location of the mobile terminal, the present invention allows the user of the mobile terminal to access very specific content tailored to the current location of the mobile terminal.

The Applicant suggests that there is no indication in Owensby's disclosure that the accessed content is location specific. The Patent Office relies on Heddaya to show multiple servers that have identical content, effectively mirroring one another. The Applicant states however, that this aspect of the specification is not claimed in the new claims. The new claims recite unique location specific content at each internet protocol address. The Applicant suggests that the combination of references does not teach or suggest the addresses associated with a unique location specific content.

The Examiner respectfully disagrees with the Applicant's suggestion that the prior art does not teach all the features in the Claims 1-38.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., unique location specific content ) are not recited in the rejected claim(s) 1-38. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner respectfully disagrees with the Applicant's suggestion that the prior art does not teach all the features in the Claims 39-54.

As cited in the rejection under 35 USC 103(a) shown above, Heddaya discloses another approach for offloading servicing work from home server to an intermediate node interconnected between the home server and the client. Here, the home server sends a document and code to the intermediate node. At the intermediate node, the code executes and modifies the document. The modified document is then sent to the

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client in a more customized form. Heddaya discloses that preferably the secondary server nodes are closer to the client nodes. (Column 3 Lines 25-40) The Examiner notes that it would be obvious that each server node would have a unique internet protocol address, said address associated with storage devices containing said customized contents. The Examiner suggests that since Heddaya's intent is to select secondary or intermediate nodes that are closer to the client node, it would be obvious to select a secondary or intermediate node that is in the same geographic location as the client.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (571)272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcb

  
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